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Appeal Brief Under 37 C.F.R. §41.37(a) (18 sheets)
Appendix A (2 sheets)
Appendix B (1 sheet)
Appendix C (1 sheet)

Application Number 09/945,038
Confirmation No.: 3056
Filing Date: 31 August 2001
Document Submission Date: 14 November 2006

Art Unit: 3626
Examiner: Cobanoglu, Dilek B.
Inventor: Johnson, Ann

Docket: 1070-002

Pages: 25

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Date

Eden Brown

Name of Certifier



Signature of Certifier

NOV 14 2006

PTO/SB/17 (12-04)

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Effective on 12/08/2004. Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818). FEE TRANSMITTAL For FY 2005		Complete if Known Application Number 09/945,038 Filing Date 31 August 2001 First Named Inventor Johnson, Ann Examiner Name Cobanoglu, Dilek B. Art Unit 3828 Attorney Docket No. 1070-002	
<input checked="" type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27			
TOTAL AMOUNT OF PAYMENT	(S) 250.00		

METHOD OF PAYMENT (check all that apply)

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FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	0
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 or, for Reissues, each claim over 20 and more than in the original patent	50	25
Each independent claim over 3 or, for Reissues, each independent claim more than in the original patent	200	100
Multiple dependent claims	360	180

Total Claims **Extra Claims** **Fee (\$)** **Fee Paid (\$)**

 - 20 or HP = x =

HP = highest number of total claims paid for, if greater than 20

Indep. Claims **Extra Claims** **Fee (\$)** **Fee Paid (\$)**

 - 3 or HP = x =

HP = highest number of independent claims paid for, if greater than 3

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets **Extra Sheets** **Number of each additional 50 or fraction thereof** **Fee (\$)** **Fee Paid (\$)**

 - 100 = / 50 = (round up to a whole number) x =

4. OTHER FEES (\$)

	Fees Paid (\$)
Non-English Specification \$130 fee (no small entity discount)	0
Other: Filing a Brief in Support of an Appeal	250

SUBMITTED BY		
Signature <i>Michael N. Haynes</i>	Registration No. 40,014 (Attorney/Agent)	Telephone 434-972-9988
Name (Print/Type) Michael N. Haynes	Date 14 Nov 2006	

This collection of information is required by 37 CFR 1.158. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1480, Alexandria, VA 22313-1480. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1480, Alexandria, VA 22313-1480.

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PATENT

Application # 09/945,038

Attorney Docket # 1070-002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Johnson, Ann
Application # : 09/945,038
Confirmation # : 3056
Filed : 31 August 2001
Application Title : Method and System for Consumer Healthcare Decision Making
Art Unit # : 3626
Latest Examiner : Cobanoglu, Dilek B.

Mail Stop Appeal Brief-Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

APPEAL BRIEF UNDER 37 C.F.R. §41.37(a)

Sir:

The Applicants respectfully submit this appeal brief in response to the Office Action of 31 May 2006 ("the Final Office Action") finally rejecting each of the pending claims 1-4. This Appeal Brief is in furtherance of the Notice of Appeal filed 26 September 2006.

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PATENT

Application # 09/945,038

Attorney Docket # 1070-002

I. REAL PARTY IN INTEREST

The real party in interest is Subimo, LLC, a corporation having a place of business at 203 N. Salle Street, Suite 2100, Chicago, Illinois 60601. *See* Assignment (recorded 19 October 2004 at reel 015257, frame 0292).

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

III. STATUS OF CLAIMS

Claims 1-4 are pending in this application and have been finally rejected. Claims 5-12 were cancelled. Claims 1-4 are the subject of this appeal.

IV. STATUS OF AMENDMENTS

A reply to the final rejection was filed on 29 August 2006.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 1

Claim 1 recites a method for providing healthcare information and treatment options for a previously diagnosed condition of a particular healthcare consumer (see at least Abstract of the published application, U.S. Patent Publication 20030046113). The method comprises the following steps, each performed without involving a medical professional (see at least paragraphs 0001, 0018, and 0098):

1. providing, to the particular healthcare consumer, information relating to the previously diagnosed condition from at least one database, the information

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- comprising, with respect to treating the previously diagnosed condition in other healthcare consumers, for each of a plurality of healthcare providers, a measure of the healthcare provider's charges and a measure of the healthcare provider's quality (see at least Fig. 5 and paragraph 0062);
2. receiving, from the particular healthcare consumer, a plurality of criteria related to selecting a desired healthcare provider to treat the previously diagnosed condition (see at least Fig. 5 and paragraphs 0023, 0055, and 0056); and
 3. identifying, to the particular healthcare consumer, treatment options for the previously diagnosed condition, the identified treatment options comprising a listing of the plurality of healthcare providers ranked according to one or more of the prioritized criteria (see at least Fig. 5 and paragraphs 0016, 0062 and 0080).

Dependent claim 2

To independent claim 1, claim 2 adds the limitation of correlating the identified treatment options with demographic data (see at least Fig. 5 and paragraph 0029).

Dependent claim 3

To independent claim 1, claim 3 adds the limitation of correlating the identified treatment options with the plurality of criteria, the plurality of criteria selected and ranked by the particular healthcare consumer (see at least Fig. 5 and paragraphs 0018, 0028, and 0062).

Dependent claim 4

To independent claim 1, claim 4 adds the limitation of updating the at least one database (see at least Fig. 5 and paragraphs 0054, 0055, and 0062).

VI. GROUNDS OF REJECTION

Each of claims 1 through 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over various combinations of U.S. Patent No. 6,584,445 ("Papageorge") and U.S. Patent No. 5,724,379 ("Perkins"). Each of these rejections is respectfully traversed.

PATENT**Application # 09/945,038****Attorney Docket # 1070-002****VII. ARGUMENT****A. Legal Standards****1. *Prima Facie* Criteria for an Obviousness Rejection**

Over 50 years ago, in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), the Supreme Court established factors regarding the factual inquiry required to establish obviousness. The factors include:

1. determining the scope and contents of the prior art;
2. ascertaining differences between the prior art and the claims at issue;
3. resolving the level of ordinary skill in the pertinent art; and
4. considering objective evidence indicating obviousness or nonobviousness.

The Federal Circuit has applied *Graham*'s required factual inquiry in numerous legal precedents that are binding on the USPTO.

It is recognized that most patentable inventions arise from a combination of old elements and often, each element is found in the prior art. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). However, mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole. *Id.* at 1355, 1357.

Instead, "[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach... all the claim limitations." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP 2143.

Moreover, the "Patent Office has the initial duty of supplying the factual basis for its rejection." *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057, *reh'g denied*, 390 U.S. 1000 (1968). "It may not... resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis". *Id.*

It is legal error to "substitute[] supposed *per se* rules for the particularized inquiry required by section 103. It necessarily produces erroneous results." *See, In re Ochiai*, 71 F.3d

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1565, 1571, 37 USPQ2d 1127, 1132-33 (Fed. Cir. 1998); *In re Wright*, 343 F.2d 761, 769-770, 145 USPQ 182, 190 (CCPA 1965).

"Once the examiner... carries the burden of making out a *prima facie* case of unpatentability, 'the burden of coming forward with evidence or argument shifts to the applicant.'" *In re Alton*, 76 F.3d 1168, 37 USPQ2d 1578 (Fed. Cir. 1996) (*quoting In re Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444).

2. All Words in a Claim Must Be Considered

"To establish *prima facie* obviousness... '[a]ll words in a claim must be considered....'" MPEP 2143.03, *quoting In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970); *see also, In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *In re Wilder*, 429 F.2d 447, 166 USPQ 545, 548 (CCPA 1970); *In re Angstadt*, 537 F.2d 498, 190 USPQ 214, 217 (CCPA 1976); *In re Geerdes*, 491 F.2d 1260, 180 USPQ 789, 791 (CCPA 1974).

3. Pertinent Prior Art References

The *Graham* analysis requires that, to rely on a prior art reference as a basis for a rejection, the USPTO must show that the reference is "reasonably pertinent to the particular problem with which the invention was involved." *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664, 57 USPQ2d 1161, 1166 (Fed. Cir. 2000); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1535, 218 USPQ 871, 876 (Fed. Cir. 1983); *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992); *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006).

"References are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art." *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006) ("[I]t is necessary to consider 'the reality of the circumstances,'—in other words, common sense—in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor" (*quoting In re Wood*, 599 F.2d 1032, 1036 (C.C.P.A. 1979))).

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"If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection. An inventor may well have been motivated to consider the reference when making his invention. If it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it" *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006) (citing *In re Clay*, 966 F.2d 656, 659-60 (Fed. Cir. 1992)).

Yet "[d]efining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness." *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006) (quoting *Ecolchem, Inc. v. S. Cal. Edison Co.*, 227 F.3d 1361, 1372 (Fed. Cir. 2000)).

4. Teaching Away

Federal Circuit law indicates that references "that teach away cannot serve to create a *prima facie* case of obviousness." See, *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994). If a proposed combination would render a reference inoperable for its intended purpose, the reference teaches away from the proposed combination. *Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 52 USPQ2d 1294 (Fed. Cir. 1994). "If references taken in combination would produce a 'seemingly inoperative device,'... such references teach away from the combination and thus cannot serve as predicates for a *prima facie* case of obviousness". *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 60 USPQ2d 1001, 1010 (Fed. Cir. 2001).

5. Motivation or Suggestion to Combine Prior Art References

Under the *Graham* analysis, the "examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." See, MPEP 2142. The requirements for meeting this burden are clear.

To factually support a *prima facie* conclusion of obviousness, an Office Action must clearly and objectively prove "the reasons one of ordinary skill in the art would have been motivated to select the references". *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998); *In re Johnston*, 435 F.3d 1381 (Fed. Cir. 2006).

Further, "the examiner must show reasons that the skilled artisan, confronted with the

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same problems as the inventor and with no knowledge of the claimed invention, **would select the elements** from the cited prior art references for combination **in the manner claimed**" (emphasis added). *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *In re Sang-Su Lee*, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

To show these reasons, "[p]articular findings must be made". *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). Such factual findings must be supported by "concrete evidence in the record". *In re Zurko*, 258 F.3d 1379, 1385-86, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

Moreover, a showing of combinability must be "clear and particular". *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 161 (Fed. Cir. 1999). That strong showing is needed because, "**obviousness requires proof** 'that the skilled artisan . . . would select the elements from the cited prior art references for combination in the manner claimed'". *In re Johnston*, 435 F.3d 1381 (Fed. Cir. 2006) (quotation omitted) (emphasis added).

Thus, the Office Action must clearly, particularly, and objectively prove some "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; and

"combine [those teachings] in the way that would produce the claimed" subject matter.

In re Johnston, 435 F.3d 1381 (Fed. Cir. 2006) (internal citations omitted). See also, *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (discussing "the test of whether it would have been obvious to select **specific** teachings and combine them as did the applicant") (emphasis added); and *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985) ("When prior art references require selective combination... to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself."). "The absence of . . . a suggestion to combine is dispositive in an obviousness determination." *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997).

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Further, these requirements apply regardless of whether the Office Action relies upon modifying or combining purported teachings.

Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious modification of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the **desirability** of the modification.... It is impermissible to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In re Fritch, 972 F.2d 1260, 23 USPQ 2d 1780, 1783-1784 (Fed. Cir. 1992) (citing *In re Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985); and *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988) (internal quotations omitted) (emphasis added)).

B. Analysis**1. Claim 1****a. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness.

b. Missing Claim Limitations

Claim 1, from which each of claims 2-4 depend, states, *inter alia*, "**providing, to the particular healthcare consumer, information relating to said previously diagnosed condition from at least one database, said information comprising, with respect to treating the previously diagnosed condition in other healthcare consumers, for each of a plurality of healthcare**

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providers, a measure of the healthcare provider's charges and a measure of the healthcare provider's quality".

The Final Office Action applied col. 2, lines 5-15, col. 2, lines 30-36, and col. 2, line 66 – col. 3, line 27 of Perkins in support of the rejection. An Advisory Action, dated 20 September 2006 ("the Advisory Action"), attempted to introduce new grounds of rejection for this claimed subject matter adding the abstract of Papageorge; col. 7, line 60 to col. 8, line 4 of Papageorge; and col. 3, lines 54-60 of Perkins. As an initial matter, Applicant respectfully notes the procedural impropriety of sustaining finality of the final Office Action while providing new grounds of rejection for claim 1.

Applicant respectfully asks where any of the applied portions of the relied upon references teach:

- a. "providing" "the particular healthcare consumer" "information comprising", "for each of a plurality of healthcare providers", **"a measure of the healthcare provider's charges"**?
- b. "providing, to the particular healthcare consumer, information relating to said previously diagnosed condition from at least one database, said information comprising, with respect to treating the previously diagnosed condition in other healthcare consumers, for each of a plurality of healthcare providers, **a measure of the healthcare provider's charges and a measure of the healthcare provider's quality"**?

Applicant respectfully submits that the applied portion of the relied upon references fail to teach at least this claimed subject matter.

Claim 1, from which each of claims 2-4 depend, states, *inter alia*, "receiving, from the particular healthcare consumer, a plurality of criteria related to selecting a desired healthcare provider to treat the previously diagnosed condition".

The Final Office Action applied col. 2, lines 5-15 of Perkins in support of the rejection. The Advisory Action attempted to introduce new grounds of rejection for this claimed subject matter adding the abstract of Papageorge; and col. 3, lines 54-60 of Perkins. Applicant again

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respectfully notes the impropriety of sustaining finality of the final Office Action while providing additional new grounds of rejection for claim 1.

Applicant respectfully asks:

- a. how are any alleged criteria of the applied portions of the relied upon references **"related to selecting a desired healthcare provider to treat the previously diagnosed condition"**?
- b. where does any applied portion of any relied upon reference teach "receiving, from the particular healthcare consumer," such criteria?

Applicant respectfully submits that the applied portion of Perkins fails to teach at least this claimed subject matter.

Claim 1, from which each of claims 2-4 depend, states, *inter alia*, "identifying, to the particular healthcare consumer, treatment options for said previously diagnosed condition, said identified treatment options comprising a listing of the plurality of healthcare providers **ranked according to one or more of the prioritized criteria**".

The Final Office Action applied col. 2, lines 5-15, and lines 30-36 of Perkins in support of the rejection. The Advisory Action attempted to introduce yet another new grounds of rejection regarding claim 1 for this claimed subject matter adding the abstract of Papageorge; col. 5, lines 39-58 of Perkins; and col. 6, lines 10-26 of Perkins. Applicant respectfully notes the impropriety of sustaining finality of the final Office Action while providing additional new grounds of rejection for claim 1.

Applicant respectfully asks any of the applied portions of the relied upon references teach:

- a. "treatment options comprising a listing of the plurality of healthcare providers **ranked according to one or more of the prioritized criteria**"?
- b. "identifying" to "the particular healthcare consumer" "treatment options comprising a listing of the plurality of healthcare providers **ranked according to one or more of the prioritized criteria**"?
- c. "identifying, to the particular healthcare consumer, treatment options for said previously diagnosed condition, said identified treatment options comprising a

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listing of the plurality of healthcare providers **ranked according to one or more of the prioritized criteria**”?

Applicant respectfully submits that the applied portion of Perkins fails to teach at least this claimed subject matter.

The applied portions of Papageorge fail to cure at least these deficiencies of the applied portions of Perkins.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, **as attempted to be modified or combined**, still do not expressly or inherently teach every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness.

c. Papageorge Teaches Away

Claim 1 recites, “without involving a medical professional”. Nothing in Papageorge would suggest to a person of ordinary skill in the art that a combination should be made with Perkins to arrive at this claimed subject matter. Indeed, Papageorge teaches away from any such modification to arrive at the claimed subject matter because Papageorge allegedly discloses a “computerized health evaluation system for **joint patient and physician decision making** concerning particular medical diseases and conditions” (emphasis added). *See* Abstract. Since Papageorge teaches away from the claimed subject matter, any combination with any other applied reference is impermissible.

d. Motivation or Suggestion to Combine the Applied References

The Final Office Action presents insufficient evidence regarding a “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

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1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Moreover, the Final Office Action presents **insufficient evidence, of anything** "in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the **combination**." Thus, the Office Action fails to present the required **proof** of obviousness.

Instead, the Final Office Action merely recites, at Page 7:

[i]t would have been obvious to one having ordinary skill in the art at the time of the invention to have combined the computerized health evaluation system which allows for full patient participation in treatment selection and a shared decision-making process with physicians in order to choose among different costs and post-treatment outcomes with the identifying treatment options for said previously diagnosed condition, said treatment options comprising a listing of the plurality of healthcare providers ranked according to one or more of the prioritized criteria with the motivation of getting more efficient healthcare services when comparing health-care services from different providers (Perkins et al.; col. 1, lines 56-58).

Yet, this applied portion of Perkins merely states, "[w]e have discovered that health care services can be made more efficient by using a better way of comparing health care services from different providers."

Applicant respectfully asks where this applied portion of Perkins provides a "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Applicant respectfully submits that the Final Office Action fails to provide the required proof of obviousness.

PATENT**Application # 09/945,038****Attorney Docket # 1070-002****e. Conclusion**

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 1.

2. Claim 2**a. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness.

b. Missing Claim Limitations

Applicant respectfully incorporates by reference each argument presented regarding claim 1, since claim 2 depends from claim 1.

c. No Motivation or Suggestion to Combine the Applied References

The Final Office Action presents no proof, and notably no evidence whatsoever, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to", for the additional subject matter of claim 2:

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Moreover, the Final Office Action presents no proof, and indeed no evidence, of anything "in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." Thus, the Office Action fails to present the required proof of obviousness.

d. Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 2.

PATENT**Application # 09/945,038****Attorney Docket # 1070-002****3. Claim 3****a. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness.

b. Missing Claim Limitations

Applicant respectfully incorporates by reference each argument presented regarding claim 1, since claim 3 depends from claim 1.

Moreover, claim 3 states, *inter alia*, "correlating the identified treatment options with the plurality of criteria, **the plurality of criteria selected and ranked by the particular healthcare consumer.**"

The Final Office Action applied col. 6, line 66 – col. 7, line 7 of Papageorge in support of the rejection. Yet the applied portion of Papageorge recites, at col. 6, line 66 – col. 7, line 7:

[o]n electronic platforms, the patient will read screen text explaining the disease and all treatment options. After reading this overview, the patient then answers the questionnaire, using single keystrokes to select choices. This feature will maximize the number of patients who will use the system. The patient is asked about his/her functional status and how much it may be impaired; whether work, family, lifestyle, and/or future plans are affected; and treatment preferences, given the different probable risks associated with each one.

The Advisory Action attempts to cure the deficiencies of the applied portions of Papageorge by presenting new grounds of rejection citing Perkins at col. 5, lines 39-58. Again Applicant respectfully notes the procedural impropriety of maintaining a final rejection while presenting new grounds of rejection. Further, this newly applied portion of Perkins merely recites:

After the available health care experience information is linked to each of the patients so that it is computer accessible on a patient basis, we are ready to begin the comparison process. This involves selecting a comparison criteria by which the health care services rendered by different providers are to be compared: one of

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these criteria is utilization of procedures involved in the services rendered and another is indicia of quality of the services rendered. Both criteria may be used, because information is available on both and they both relate to efficiency of the health care services rendered to the patients, and because our method seeks meaningful revelation of as much information as possible. To begin the comparison process, we computer process the health care experience information from the data bases relative to the orders of clinical complexity to determine the degree or extent to which each of the efficiency comparison criteria systematically relates to the clinical complexity groups. To do this, we prefer a regression analysis, such as explained in *Principals of Econometrics* by Henri Theil, New York, Wiley, 1971.

Applicant respectfully asks where any of these applied portions of the relied upon references teach:

- a. that any criteria are "ranked"?
- b. that "the plurality of criteria" are "ranked by the particular healthcare consumer"?
- c. "correlating the identified treatment options with the plurality of criteria, the plurality of criteria selected and ranked by the particular healthcare consumer"?

c. No Motivation or Suggestion to Combine the Applied References

The Final Office Action presents no proof, and notably no evidence whatsoever, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to", for the additional subject matter of claim 3:

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Moreover, the Final Office Action presents no proof, and indeed no evidence, of anything "in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." Thus, the Office Action fails to present the required proof of obviousness.

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d. Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 3.

4. Claim 4

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness.

b. Missing Claim Limitations

Applicant respectfully incorporates by reference each argument presented regarding claim 1, since claim 4 depends from claim 1.

c. No Motivation or Suggestion to Combine the Applied References

The Final Office Action presents **no proof, and notably no evidence** whatsoever, of any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”, for the additional subject matter of claim 4:

1. “select the references”;
2. “select the teachings of [the] separate references”; or
3. “combine [those teachings] in the way that would produce the claimed” subject matter.

Moreover, the Final Office Action presents **no proof, and indeed no evidence, of anything** “in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the **combination**.” Thus, the Office Action fails to present the required **proof** of obviousness.

d. Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 4.

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VIII. CLAIMS APPENDIX

Appendix A sets forth all pending claims in the state in which they were appealed.

IX. EVIDENCE APPENDIX

Appendix B sets forth copies of any evidence submitted pursuant to 37 C.F.R. § 1.130, 37 C.F.R. § 1.131, or 37 C.F.R. § 1.132 or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner.

X. RELATED PROCEEDINGS APPENDIX

Appendix C sets forth copies of decisions rendered by a court or the Board in any proceeding identified pursuant to 37 C.F.R. § 41.37(c)(1)(ii)

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SUMMARY

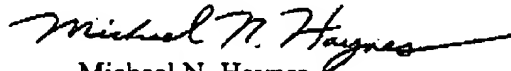
In view of the above, Applicants submit that all claims on appeal distinguish over the cited art and respectfully request that the Examiner's rejections of these claims should be reversed.

Applicants therefore respectfully request that the Board of Patent Appeals and Interferences reverse the Examiner's decision rejecting claims 1-4 and direct the Examiner to pass the case to issue.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. §1.16 or §1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

Michael Haynes PLC



Michael N. Haynes
Registration No. 40,014

Date: 14 November 2006

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Applicant(s) : Johnson, Ann
Application # : 09/945,038
Confirmation # : 3056
Filed : 31 August 2001
Application Title : Method and System for Consumer Healthcare Decision Making
Art Unit # : 3626
Latest Examiner : Cobanoglu, Dilek B.

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPENDIX A

1. A method for providing healthcare information and treatment options for a previously diagnosed condition of a particular healthcare consumer, said method comprising the steps of:
without involving a medical professional:

providing, to the particular healthcare consumer, information relating to said previously diagnosed condition from at least one database, said information comprising, with respect to treating the previously diagnosed condition in other healthcare consumers, for each of a plurality of healthcare providers, a measure of the healthcare provider's charges and a measure of the healthcare provider's quality;

receiving, from the particular healthcare consumer, a plurality of criteria related to selecting a desired healthcare provider to treat the previously diagnosed condition;
and

identifying, to the particular healthcare consumer, treatment options for said previously diagnosed condition, said identified treatment options comprising a listing

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of the plurality of healthcare providers ranked according to one or more of the prioritized criteria.

2. The method of claim 1, further comprising the step of correlating the identified treatment options with demographic data.
3. The method of claim 1, further comprising the step of correlating the identified treatment options with the plurality of criteria, the plurality of criteria selected and ranked by the particular healthcare consumer.
4. The method of claim 1, further comprising the step of updating said at least one database.

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APPENDIX B

No evidence appendices are presented.

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APPENDIX C

There are no decisions in any related proceedings.